

Remarks

The present Amendment is submitted in response to the Office Action dated July 24, 2008, which set a three-month period for response. Reconsideration and allowance of the application in view of the amendments above and the following remarks is respectfully requested.

In the Office Action, claims 1-6, 9 and 10 are rejected under 35 USC §102(b) as anticipated by US Patent No. 5,919,085 to Izumisawa (Izumisawa). Claims 7 and 8 are rejected under 35 USC §103(a) as unpatentable over Izumisawa in view of US Patent No. 4,287,685 to Marton (Marton).

The Specification was objected to for use of the term "discharge," and for use of the phrase "directly above" at page 6, line 26. In response, applicants have amended the Abstract, and the Specification in paragraphs beginning at page 1, line 31, page 4, line 23 and page 6, line 17 as shown above. For example, instead of "discharges," the Specification and Abstract are amended to reflect that the conduit (18) opening at the face end (14) is for intake, and "directly above" to "directly within" the annular gap opening. Withdrawal of the objections to the Specification is therefore respectfully requested.

In response to the rejection of claims 1 -10 under 35 USC §112, second paragraph, as indefinite, applicants have amended claims 1-5 and 9, and cancelled claims 6-8 and 10 without prejudice or disclaimer of subject matter. The amendments to claims 1-5 and 9, as shown above, are believed to be fully

responsive to the points raised by the Examiner. For example, claim 4 is amended as follows:

the suction conduit (18) has an inner radial limitation, in at least one region, which comprises has a spacing of less than 1 cm from the driven shaft (16).

Support for claim 4 as amended is found at page 5, lines 6-10. Support for the claim 9 amendment is found in cancelled claim 10 and Figs. 1-3 and 6.

Applicants therefore respectfully request withdrawal of the rejection of claims 1-5 and 9 under 35 USC §112, second paragraph.

Applicants present new claims 11-22 for examination, as shown above. Support for new claims 11 and 12 is found in Fig. 1; support for new claim 13 is found in Fig. 1 and at page 4, lines 26-27; support for new claims 14 and 15 is found at Fig. 1 and page 4, lines 28-30; support for new claim 16 is found at Fig. 1, and page 4, line 32 through page 5, line 2; support for new claims 17, 18 and 19 is found at Figs. 1-3 and 6, and at page 5, lines 8-10; support for new claim 20 is found at Figs. 1-3 and 6, and at page 6, lines 19-20; support for new claim 21 is found at Figs. 1-3 and 6, and at page 6, lines 19-21; and support for new claim 20 is found at Figs. 1-3 and 6, and at page 6, lines 21-24.

Claims 1-5, 9 and 11-22 are pending hereinafter, where claims 1 and 9 are the independent claims.

Turning now to the substantive rejection of the claims, applicant respectfully submits that claims 1-5, 9 (and newly presented claims 11-22), are

patentable over Izumisawa, whether taken alone or in combination with Marton, for at least the following reasons.

Applicants' amended independent claim 1 calls out a hand-held power tool, in particular a sander, comprising a housing (10) and a motor (12), which is located in the housing (10) and by which a driven shaft (16), extending from a face end (14) of the housing (10), is drivable, and further comprising a suction conduit (18), extending at least partway through the housing (10), wherein the suction conduit (18) operates as an intake at a face end (14) of the housing.

Applicants independent claim 9 calls out a system comprising hand-held power tool, in particular a sander, comprising a housing (10) and a motor (12), which is located in the housing (10) and by which a driven shaft (16), extending from a face end (14) of the housing (10), is drivable, and further comprising a suction conduit (18), extending at least partway through the housing (10), and further comprising a tool receptacle with a suction conduit (20), wherein the suction conduit (18) in the housing (10) of the hand-held power tool and the suction conduit (20) in the tool receptacle are intended for direct coupling such that an installed state of the tool receptacle are coupled via a region (26) that is open in a radial direction towards the outside of the hand-held power tool and the tool receptacle.

Izumisawa is readily patentably distinguishable from independent claims 1 and 9. Izumisawa discloses an abrading tool comprising a housing (1), and includes an abrading pad (28) mounted at a lower end of a spindle (25) of the

abrading tool. As understood by applicants, housing 1 is included for mounting a driving motor and gearing attached thereto. The abrading pad (28) includes openings (30) to allow dust and debris to pass through and flow into an exhaust duct (42) in a second housing (35) of the abrading tool. The second housing (35) is attached to housing (1) via a top (36). The second housing (35) includes a skirt (40) that extends in an axial direction of a spindle (25) and covers the pad (28) to avoid contact with adjacent objects (col. 4, lines 2-41). The second housing (35) essentially comprises part of exhaust duct or pathway (42), and leads dust and debris to a hose (43) arranged at one end of the second housing (35; Fig.1, col. 4, line 25-col. 2, line 5).

Izumisawa's second housing (35) does not surround any region of the motor in the housing (1); the second housing (35) is separate from housing (1) (see hatchings of Fig. 1). Izumisawa, therefore, does not include a suction conduit (18), extending at least partway through the housing (10), wherein the suction conduit (18) operates an intake at a face end (14) of the housing, a limitation of each of independent claims 1 and 9. Izumisawa, therefore, cannot provide the advantageous suction extraction provided by applicants' claims 1 and 9, as described in detail at page 1, lines 24-31 of applicant's specification.

Izumisawa's Fig. 1 and specification at col. 4, lines 32-41, teaches that the skirt (40) arrangement at the lower end of the second housing (35) covers pad (28) to avoid hazardous contact between the pad (28) and adjoining objects, such as the operator. This is distinguished from applicant's system of claim 9,

which includes in an installed state the tool receptacle connected to the hand-held power tool via a region (26) that is open in a radial direction towards the outside of the hand-held power tool and tool receptacle (see claim 9 as amended).

Due to region (26), a simple coupling without additional components is attained and an advantageous suction extraction of dust from a region outside of the suction conduit (18) is realized by same coupling. Izumisawa's construction does not provide a region open in a radial direction toward an outside of the tool and pad (28). A gap between the housing and second housing is covered by skirt (40) to avoid pad contact, as mentioned. Izumisawa, therefore, cannot provide the advantageous suction extraction provided by applicants' claim 9, in the installed state of the tool receptacle. Because amended independent claim 9 recites this limitation, and both claims 1 and 9 recite the limitation that housing (10) includes a suction conduit (18) extending from face end (14) at least part way through the housing (10), which Izumisawa does not, Izumisawa does not anticipate the inventions as claimed.

Applicant further respectfully asserts that Izumisawa is not a proper reference under 35 USC §102 pursuant to the guidelines set forth in the last paragraph of MPEP §2131, where it is stated that "a claim is anticipated only if each and every element as set forth in the claims is not found, either expressly or inherently described, in a single prior art reference," and that "the identical invention must be shown in as complete detail as is contained in the ... claim."

Amended independent claims 1 and 9 are therefore patentable under 35 USC §102(b) over Izumisawa. Claims 2-5, which depend from claim 1 also are patentable under section 102(b) over Izumisawa for at least the same reasons. The rejection of claims 7 and 8 under section 103(a) over Izumisawa in view of Marton are obviated in view of the cancellation of those claims. Moreover, applicants respectfully assert that newly presented claims 11-22 are patentable over Izumisawa, or Izumisawa combined with Marton.

Applicants, therefore, respectfully request withdrawal of the rejection of claims 1-5 and 9 over Izumisawa under section 102(b), and the allowance of each of claims 1-5, 9 and 11-22.

Accordingly, the application as amended is believed to be in condition for allowance. Action to this end is courteously solicited. However, should the Examiner have any further comments or suggestions, the undersigned would very much welcome a telephone call in order to discuss appropriate claim language that will place the application in condition for allowance.

Respectfully submitted,  
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